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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,664	05/25/2000	William Reeves		5874

7590 01/06/2004

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/578,664

Applicant(s)

REEVES, WILLIAM

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Response to Amendment***

1. In the amendment filed 9/22/03 in paper number 14, the following has occurred: claims 1-12 have been canceled and claims 13-80 have been added. Now, claims 13-80 are presented for examination.

***Claim Objections***

2. Claims 14-21, 23-31, 33-43 and 45-46 are objected to because of the following informalities: These claims are recited as being dependent on claim 1; however, claim 1 has been rejected. The Examiner assumes that this is a typographical error and that these claims should be dependent on claim 13. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-46, 53-55, 61, 62, 64, 70, 73, and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 13-46 are directed to a "computer system for inputting, storing, organizing and retrieving..." however, the claims fail to recite any system elements of which the system comprises. Only steps are recited without reciting any system elements that perform the steps.

6. Claim 17 recites the phrase "the...unique digital physician signature, and priority code" in lines 1 and 2. Claim 17 is dependent on claim 13 which makes no reference to a digital

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physician signature or priority code. Therefore, there is insufficient antecedent basis for this limitation in the claim.

7. Claim 19 recites the phrase "the unique digital physician signature" in line 2. Claim 19 is dependent on claim 13 which makes no reference to a digital physician signature. Therefore, there is insufficient antecedent basis for this limitation in the claim.

8. Claims 20 and 21 recite the phrase "the retrieval request" in line 3. Claims 20 and 21 are dependent on claim 13 which makes no reference to a retrieval request. Therefore, there is insufficient antecedent basis for this limitation in the claim.

9. Claims 27, 28, 30, 36, and 42 recite the phrase "said digital physician signature" in lines 1, 2, 1, 3, and 3 respectively. Claims 27, 28, 30, 36, and 42 are dependent on claim 13 which makes no reference to a digital physician signature. Therefore, there is insufficient antecedent basis for this limitation in the claims.

10. Claims 53-55, 61, 62, 64, 70, 73, and 76 contain substantially similar antecedent basis deficiencies as those listed above and, as such, are rejected for similar reasons.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 13, 17-20, 37, 40, 41, 47, 51-54, 71, 74, and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilhelm, U.S. Patent No. 5,319,543.

13. As per claim 13, Wilhelm teaches a computer system for inputting, storing, organizing and retrieving patient/user medical records, clinical tests, and personal identification data,

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primarily for use in emergency medical situations, comprising: (a) providing medical records, clinical tests and other personal information and identification information of a patient/user (see column 5, lines 16-19); (b) converting the medical records, clinical tests and other personal information to a digital record for storage in a data storage device (see column 5, lines 16-22); (c) assigning a unique alpha numerical patient identifier code to the patient records and information (see column 4, lines 17-24, this identifying data includes a patient identifier as indicated by listed search criteria at column 6, lines 7-10); (d) providing a means for updating said patient/user medical information on a routine basis as their medical condition, prescriptions and clinical tests change (see column 6, lines 40-54, note the Examiner is interpreting the entering of additional information including diagnosis codes, procedural codes, and abstract information to encompass updating medical information); (e) providing a means of retrieving the medical records and data based on the users unique alpha numerical identifier (see column 6, lines 7-13).

14. As per claim 17, Wilhelm teaches the computer system of claim 13 as described above, wherein the digital records with assigned unique patient identifier, are stored in a data storage device (see column 3, lines 49-59).

15. As per claim 18, Wilhelm teaches the computer system of claim 13 as described above, wherein a request may be entered to retrieve patient medical records and other information using the unique alpha numerical patient identifier or other records identification means (see column 6, lines 7-14).

16. As per claim 19, Wilhelm teaches the computer system of claim 13 as described above, wherein a request may be entered to retrieve patient medical records and other information using a digital physician signature or other records identification means (see column 6, lines 7-14, note that the claim recites retrieving using a digital physician signature or other records

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identification means, therefore, the Examiner is reading the "other records identification means" onto the record retrieval element of Wilhelm.

17. As per claim 20, Wilhelm teaches the computer system of claim 13 as described above, wherein patient medical records and other information may be retrieved if the unique alpha numerical patient identifier entered with the retrieval request matches a stored database of patient identifiers (see column 4, lines 20-24 and column 6, lines 7-14).

18. As per claim 37, Wilhelm teaches the system of claim 13 as described above, wherein the patient records can be accessed from a remote location and printed in hard copy format via any appropriate black and white or color printing means wherein the medical diagnostic and medical integrity of the records is maintained, for emergency medical treatment or other medical purposes (see column 4, lines 54-55).

19. As per claim 40, Wilhelm teaches the system of claim 13 as described above, wherein a plurality of data inputs from remote locations, including said unique optical scanners and/or existing digital databases, can transmit and receive secure patient records, for access in a medical emergency and for other medical scenarios (see column 4, lines 42-48).

20. As per claim 41, Wilhelm teaches the system of claim 13 as described above, having appropriate remote and local computer workstations to input, transmit and receive said patient records and data 25 hours a day to service medical emergencies and other medical scenarios (see column 4, lines 42-48).

21. Claims 47, 51-54, 71, 74, and 75 contain substantially similar limitations to claims 13, 17-20, 37, 40, and 41 and, as such, are rejected for similar reasons as given above.

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***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 48, 49, 55, 66, 70, 14, 15, 21, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm, U.S. Patent No. 5,319,543 in view of Hoffman et al., U.S. Patent No. 5,613,012.

24. As per claim 14, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach that simultaneously with digitizing the medical records and user ID information, a unique digital alpha numerical watermark is embedded into the document to verify its authenticity. Hoffman teaches a system of authorization of electronic transactions for verifying the unique identity of a user (see abstract) including the feature of embedding a unique digital alpha numerical watermark into a document to verify its authenticity (see column 74, line 65 – column 75, line 4). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to employ the digital watermarking of documents of Hoffman within the system of Wilhelm. One of ordinary skill in the art would have been motivated to add this feature to the system of Wilhelm for the purpose of enhancing its security and accuracy.

25. As per claims 15 and 36, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach that simultaneously with digitizing the medical records and user ID information, a unique digital alpha numerical digital physician signature is assigned and embedded into the document. Hoffman teaches a system of authorization of electronic transactions for verifying the unique identity of a user (see abstract) including the feature of

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embedding a unique digital alpha numerical digital signature into a document to verify its authenticity (see column 74, line 65 – column 75, line 4). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to employ the digital signature feature of Hoffman within the system of Wilhelm. One of ordinary skill in the art would have been motivated to add this feature to the system of Wilhelm for the purpose of enhancing its security and accuracy.

26. As per claim 21, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach retrieving medical records based on matching the digital physician signature with a stored digital physician signature. Hoffman teaches verifying a supplied digital signature by matching it with a digital signature stored within a database (see column 75, lines 5-10). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to employ the digital signature feature of Hoffman within the system of Wilhelm. One of ordinary skill in the art would have been motivated to add this feature to the system of Wilhelm for the purpose of enhancing its security and accuracy.

27. As per claim 32, Wilhelm in view of Hoffman teaches the system of claim 15 as described above. Wilhelm further teaches comparing new and existing patient records to verify their originality and medical integrity (see column 6, lines 65-67).

28. Claims 48, 49, 55, 66, and 70 contain substantially similar limitations to claims 14, 15, 21, 32, and 36 and, as such, are rejected for similar reasons as given above.

29. Claims 16, 22-27, 31, 33, 34, 38, 39, 42, 50, 56-61, 65, 67, 68, 72, 73, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm, U.S. Patent No. 5,319,543 in view of Surwit et al., U.S. Patent No. 6,024,699.



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30. As per claim 16, Wilhelm teaches the system of claim 13 as described above, wherein a priority code is assigned to the digital records (see column 2, lines 16-26, i.e. subsets of Wilhelm). Wilhelm does not explicitly teach assigning a priority code based on the clinical significance of the record, severity of condition and relevance to providing medical treatment to the user/patient. Surwit teaches assigning a priority code to medical records based on clinical significance of the record, severity of condition and relevance to providing medical treatment (see column 14, lines 32-38 and column 15, lines 12-28). It would have been obvious to one of ordinary skill in the art of medical records at the time of the invention to incorporate this type of assigning of priority codes within the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of patient record retrieval.

31. As per claim 22, Wilhelm in view of Surwit teach the system of claim 16 as described above. Wilhelm does not explicitly teach assigning a priority code based on a weighted average or other calculated means, based on the severity of the medical condition, and its clinical relevance in treating the patient/user during a medical emergency, or for other routine medical treatments. Surwit teaches such an assigning feature (see column 15, lines 29-39). It would have been obvious to one of ordinary skill in the art of medical records at the time of the invention to incorporate this type of assigning of priority codes within the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of patient record retrieval.

32. As per claim 23, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach that the patient/user medical data is condensed and organized in data fields in digital page format. Surwit teaches condensing and organizing patient medical data into data fields in digital page format (see Figure 8). It would have been obvious to one of

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ordinary skill in the art of medical records at the time of the invention to incorporate this feature into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of aiding physicians in concisely viewing patient records.

33. As per claim 24, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach organizing patient/user medical data into data fields based on the clinical relevance or utility of the data in treating a patient in a medical emergency, or other medical scenario. Surwit teaches such an organizational feature (see Figure 8). It would have been obvious to one of ordinary skill in the art of medical records at the time of the invention to incorporate this feature into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of aiding physicians in concisely viewing patient records.

34. As per claims 25-27, 33 and 38, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach providing intra or internet access for accessing personal information. Surwit teaches providing internet access for accessing personal medical information (see column 6, lines 31-39). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to use the internet for retrieving medical records. One of ordinary skill in the art would have been motivated to use such an embodiment for the purpose of providing broader access to the system of Wilhelm.

35. As per claim 31, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach encrypting the user/patient medical data for securing confidentiality. Surwit teaches encrypting medical data to secure confidentiality (see column 10, lines 29-33). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to incorporate this feature into the system of Wilhelm. One of

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ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the security of the system of Wilhelm.

36. As per claim 34, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach electronically transmitting said patient medical records and data to remote locations vial electronic means. Surwit teaches electronically transmitting patient medical records and data to remote locations vial electronic means (see column 9, lines 50-58). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time of the invention to incorporate this feature into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of providing broader access to the system of Wilhelm.

37. As per claims 35 and 42, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach utilizing a telephone exchange system and a plurality of computer workstations to allow for a plurality of different patient records to be simultaneously transmitted and received by the system. Surwit teaches such a telephone exchange system (see column 9, lines 25-31). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time of the invention to incorporate this feature into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of providing broader access to the system of Wilhelm.

38. As per claim 39, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach a signal controller that allows a plurality of patient records to be simultaneously transmitted and received without data corruption or crosstalk, security checked with said patient identifier. Surwit teaches such a signal controller (see column 11, lines 36-48). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time of the invention to incorporate this feature into the system of Wilhelm. One of ordinary skill

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in the art would have been motivated to incorporate this feature for the purpose of providing broader access to the system of Wilhelm.

39. Claims 50, 56-61, 65, 67, 68, 72, 73, and 78 contain substantially similar limitations to claims 16, 22-27, 31, 33, 34, 38, 39, and 42 and, as such, are rejected for similar reasons as given above.

40. Claims 28-30 and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm, U.S. Patent No. 5,319,543 in view of Bardy, U.S. Patent No. 6,312,378.

41. As per claim 28, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach said digital record being retrieved using e-mail access. Bardy teaches retrieving a digital medical record using e-mail access (see column 11, lines 7-14). Further in Wilhelm it is possible to embody the system in numerous hardware configurations (see column 4, lines 6-8). Therefore, it would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to use e-mail for retrieving medical records as taught by Bardy. One of ordinary skill in the art would have been motivated to use such an embodiment for the purpose of providing broader access to the system of Wilhelm.

42. As per claims 29 and 30 Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach said digital record being retrieved using telephone voice access. Bardy teaches retrieving a digital medical record using telephone access (see column 11, lines 7-14). Further Wilhelm it is possible to embody the system in numerous hardware configurations (see column 4, lines 6-8). Therefore, it would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to use telephone voice access for retrieving medical records as taught by Bardy. One of ordinary skill

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in the art would have been motivated to use such an embodiment for the purpose of providing broader access to the system of Wilhelm.

43. Claims 62-64 contain substantially similar limitations to claims 28-30 and, as such, are rejected for similar reasons as given above.

44. Claims 43, 44, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm, U.S. Patent No. 5,319,543 in view of Bardy, U.S. Patent No. 6,312,378 and further in view of De La Hueraga, U.S. Patent No. 6,255,951.

45. As per claims 43 and 44, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach that the patient can wear or carry a medical device which designates that person has a medical condition and that their medical records are accessible using a 24 hour telephone communication system. De La Hueraga teaches a medical device that is worn by a patient designating that the patient has a medical condition and that their medical records are accessible using a communication system (see column 16, lines 16-29). Furthermore, Bardy teaches retrieving a digital medical record using telephone access (see column 11, lines 7-14). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to employ these features into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate such features for the purpose of providing a cost effective means of identifying a patient and their medical conditions at any time as well as providing broader access to the system of Wilhelm.

46. Claims 77 and 78 contain substantially similar limitations to claims 43 and 44 and, as such, are rejected for similar reasons as given above.

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47. Claims 45, 46, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm, U.S. Patent No. 5,319,543 in view of Surwit et al., U.S. Patent No. 6,024,699 and further in view of De La Hueraga, U.S. Patent No. 6,255,951.

48. As per claims 45 and 46, Wilhelm teaches the system of claim 13 as described above. Wilhelm does not explicitly teach that the patient can wear or carry a medical device which designates that person has a medical condition and that their medical records are accessible using the Internet. De La Hueraga teaches a medical device that is worn by a patient designating that the patient has a medical condition and that their medical records are accessible using a communication system (see column 16, lines 16-29). Furthermore, Surwit teaches providing internet access for accessing personal medical information (see column 6, lines 31-39). It would have been obvious to one of ordinary skill in the art of electronic medical records at the time the invention was made to incorporate these features into the system of Wilhelm. One of ordinary skill in the art would have been motivated to incorporate such features for the purpose of providing a cost effective means of identifying a patient and their medical conditions at any time as well as providing broader access to the system of Wilhelm.

49. Claims 77 and 78 contain substantially similar limitations to claims 45 and 46 and, as such, are rejected for similar reasons as given above.

### ***Response to Arguments***

50. In the remarks filed 11/25/02 in paper number 8, Applicant argues in substance that (1) both Wilhelm and Campbell are directed to a different scope of invention and practical intent from that of the present application; (2) Wilhelm does not provide "original" documents for digitizing; (3) Wilhelm does not teach converting medical records into digital records; (4) Wilhelm does not teach assigning a unique patient identifier to the digital record; (5) Wilhelm

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does not teach assigning a priority code to the digital record; (6) Wilhelm does not teach making a request for a medical record using a unique patient identifier; (7) Campbell does not teach a set of alphanumerical characters which represents the physician's digital signature; (8) Bardy does not teach the sending of medical records as intended by Applicant using email or phone.

51. It should be noted Applicant's arguments were presented prior to the filing of the current amendment and, as such, numerous arguments do not correspond to the claims as now recited. Therefore, the Examiner will respond to Applicant's argument to the extent that they apply to the claims as now recited.

52. In response to Applicant's argument (1), it is respectfully submitted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the Examiner respectfully submits that the claims have been given the broadest reasonable interpretation to one of ordinary skill in the art and while the Examiner does not necessarily dispute Applicant's assertions directed to the practical intent of the applied prior art, such assertions are not persuasive in view of the claims as recited.

53. Applicant's argument (2) is moot in view of the claims as now recited. In particular, the claims do not a step of providing "original" documents.

54. In response to Applicant's argument (3), the Examiner respectfully disagrees with Applicant's interpretation of the teachings of Wilhelm. In particular, Wilhelm teaches at least two different methods for converting medical records into digital records: (1) utilizing an optical

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scanner to enter and store medical documents on a computer readable medium (see column 5, lines 16-19) and (2) performing the same process using optical character recognition (see column 5, lines 22-24). The Examiner respectfully submits that these two methods are directed to storing medical records in a digital format for later retrieval and viewing on a computer display.

55. In response to Applicant's arguments (4) and (6), again, the Examiner respectfully disagrees with Applicant's interpretation of the teachings of Wilhelm. Wilhelm clearly teaches that patient records have identifying information associated with them for the purpose of searching for and retrieving a particular patient record (see column 6, lines 7-13). Clearly this information is alphanumeric and uniquely identifies each patient. Furthermore, the term patient identifier is not further defined within the claims and, as such, has been given the broadest reasonable interpretation to one of ordinary skill in the art. Therefore the Examiner respectfully submits that this limitation is taught by Wilhelm given the claims as presently recited.

56. In response to Applicant's argument (5), it should be noted that assigning a priority code is not recited in either of the independent claims and, therefore, is not applicable to all of the claims as now recited. Furthermore, given how the assigning of a priority code is now recited in the claims, the Examiner has relied upon a combination of the teachings of Wilhelm and Surwit. Therefore, the Examiner respectfully directs Applicant's attention to the rejections applied above.

57. Applicant's argument (7) is moot in view of the new grounds of rejection detailed above.

58. In response to Applicant's argument (8), the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Examiner has merely relied upon the teachings of Bardy for transmission of patient information



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via email and telephone. The Examiner has not relied upon Bardy to teach a particular form of patient records. Therefore, these arguments are not persuasive given the rejections as detailed above.

### ***Conclusion***

59. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

60. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

61. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

62. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

63. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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CLG

12/27/03



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600